

MPEP § 706.02(j). Furthermore, as pointed out by the Patent Office Board of Appeals and Interferences:

The examiner should be aware that "deeming" does not discharge [her] from the burden of providing the requisite factual basis and establishing the requisite motivation to support a conclusion of obviousness.

Ex parte Stern, 13 USPQ2d 1379 (BPAI 1989).

A. Claims 1-11 and 21-27

Claim 1 is an independent claim and claims 2-11 and 21-30 depend from claim 1.

1. Independent claim 1

Claim 1 recites:

Claim 1 (previously presented): A portable media device, comprising:
a memory configured to store digital content;
a wireless transceiver configured to wirelessly transmit and receive digital content;
an output configured to render digital content; and
a controller coupled to the memory, the wireless transceiver and the output, the controller being configured to authorize wireless transmission of a transfer file to a third party device in accordance with meta-data associated with a particular digital content and without regard to any identifier of the third party device, the transfer file including meta-data containing permissions information restricting rendering of the particular digital content by the third party device.

The Examiner has asserted that on page 3, line 30, through page 4, line 20, Thomson discloses all of the elements recited in claim 1, except that "Thomson does not disclose, but Audible does, a portable media device such that playback may take place virtually anywhere."

a. The Examiner has failed to establish a proper *prima facie* case of obviousness

As shown by the following detailed analysis, the cited section of Thomson does not support the Examiner's assertion that Thomson teaches all of the elements recited in claim 1 except that these features are part of a portable media device. In fact, the cited section of Thomson does not disclose any of the features recited in claim 1.

| Location in Thomson's Disclosure (page/line numbers) | Quoted Text of Thomson's Disclosure | Analysis |
|--|---|---|
| page 3, lines 30-32 | It is within the scope of the invention to substitute a "time model" for the "cost model", that is, the amount of time that a program is authorized to be viewed may be controlled. | No teaching or suggestion of <u>any</u> of the features recited in claim 1. |
| page 3, lines 34-36 | These and other aspects of the invention will be explained with reference to a preferred embodiment of the invention shown in the accompanying Drawings. | No teaching or suggestion of <u>any</u> of the features recited in claim 1. |
| page 4, lines 1-20 | Brief Description of the Drawing Figure 1 is a block diagram illustrating a home network comprised of various digital devices that may receive scrambled content from a plurality of sources; Figure 2a is a diagram defining a typical entitlement control message (ECM); Figure 2b is a diagram defining a nested ECM in accordance with one embodiment of the present invention; Figure 2c is a diagram defining an Extended ECM in accordance with another embodiment of the present invention; and Figure 3 is a block diagram illustrating a typical home network employing the present invention. | No teaching or suggestion of <u>any</u> of the features recited in claim 1. |

Thus, contrary to the Examiner's assertion, the cited section of Thomson does not disclose any of the features recited in claim 1. Although Audible does disclose a portable hardware playback device 230, Audible does not make-up for the failure of Thomson to teach or suggest features recited in claim 1. For example, neither Thomson nor Audible teaches or suggests a portable media device that has a controller that is configured to authorize wireless transmission of a transfer file to a third party device in accordance with meta-data associated

with a particular digital content and without regard to any identifier of the third party device, where the transfer file includes meta-data containing permissions information restricting rendering of the particular digital content by the third party device. Since neither of the cited references teaches or suggests such a feature, no possible combination of the cited references could teach or suggest such a feature. Accordingly, the Examiner has failed to establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103 and the rejection of claim 1 should be withdrawn.

In addition, the Examiner has not provided any explanation whatsoever as to why and how one having ordinary skill in the art at the time the current invention was made would have been motivated to modify the teachings of Thomson based on the teachings of Audible to arrive at the invention recited in claim 1. The Examiner has failed to point to any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings, as required for a proper rejection under 35 U.S.C. § 103 (see MPEP § 706.02(j), quote above). Without a proper explanation for combining these references, the Examiner again has failed to establish a proper *prima facie* case for obviousness under 35 U.S.C. § 103 and the rejection of claim 1 should be withdrawn.

b. In any event, claim 1 is not obvious over Thomson in view of Audible

Thomson discloses a copy protection system for a home network 10 that includes one or more viewing devices (e.g., a DTV 14 or a STB 12) and one or more playback devices (e.g., a DVCR 16 or a DVD player 18). The viewing devices and the playback devices are equipped with smart cards 30 that are configured to decode scrambled digital content that is stored on digital media (e.g., a DT 26 or a DVD 28). The Examiner has acknowledged that Thomson does not teach or suggest that any of the viewing devices or any of the playback devices is a portable media device. In addition, Thomson does not even hint that any of the viewing devices or any of the playback devices could include a wireless transceiver configured to wirelessly transmit digital content, as recited in claim 1. Thomson also fails to teach or suggest that any of the viewing devices or any of the playback devices could include a controller that is configured to authorize wireless transmission of a transfer file to a third party device in accordance with meta-data associated with a particular digital content and

without regard to any identifier of the third party device, where the transfer file includes meta-data containing permissions information restricting rendering of the particular digital content by the third party device.

Audible discloses a method for managing licenses for digital content in accordance with which hardware playback devices 230, 400 and software players running on computer systems 240 are configured to playback digital content received from a service provider server 210. Audible teaches that the "Player 400 is a mobile playback device that allows digital content to be downloaded, for example, via a playback device interface [and] played back layer" (page 7, lines 4-5). According to Audible (page 7, lines 8-19):

Player 400 includes buttons 405, 410, 415, 420 and 425 and volume dial 430. Further details of player 400 can be found in U.S. Patent application number 08/114,114 filed September 12, 1996. In summary, player 400 includes a processor and internal random access memory (RAM), read only memory (ROM) and a memory storage device such as flash memory. In one embodiment the ROM stores an operating system, while the flash memory (or other memory storage device) stores digital content.

Player 400 can also include an interface to receive removable media to store digital content. For example, flash memory cards storing audio content can be inserted into player 400. Digital content stored on the removable media can be played back directly from the removable media or copied from the removable media and stored in player 400 for later playback.

In this description, Audible does not even hint that the player 400 could include a wireless transceiver configured to wirelessly transmit digital content, as recited in claim 1. Nor does this description suggest that the player 400 could include a controller that is configured to authorize wireless transmission of a transfer file to a third party device in accordance with meta-data associated with a particular digital content and without regard to any identifier of the third party device, where the transfer file includes meta-data containing permissions information restricting rendering of the particular digital content by the third party device.

In FIG. 5, Audible shows that a content provider 520 distributes digital content to the playback devices 550, 560 (which may be hardware playback devices or software playback devices) through a license management device 510 over a network 500. Audible also explains that the "Playback devices can also receive digital content from other sources such as removable media (e.g., CD-ROM, flash memory cards) or one way communications (e.g.,

broadcast)" (page 8, lines 2-4). Audible, however, does not disclose any embodiments in which the mobile playback devices are configured to wirelessly transmit digital content and to authorize wireless transmission of a transfer file to a third party device in accordance with meta-data associated with a particular digital content and without regard to any identifier of the third party device, as recited in claim 1.

To summarize, neither Thomson nor Audible teaches or suggests a portable media device that has a wireless transceiver configured to wirelessly transmit digital content and a controller that is configured to authorize wireless transmission of a transfer file to a third party device in accordance with meta-data associated with a particular digital content and without regard to any identifier of the third party device, where the transfer file includes meta-data containing permissions information restricting rendering of the particular digital content by the third party device. Accordingly, no possible combination of Thomson and Audible could possibly teach or suggest such a portable media device.

For at least these additional reasons, the Examiner's rejection of independent claim 1 under 35 U.S.C. § 103(a) over Thomson and Audible should be withdrawn.

2. Claims 2-11 and 21-30

Each of claims 2-11 and 21-30 incorporates the features of independent claim 1 and therefore is patentable for at least the same reasons explained above. Claims 4, 6-10, and 21-24 also are patentable for the following additional reasons.

a. Claim 4

Claim 4 recites that the controller is configured to confirm a user license based upon a comparison of a user identifier embedded in the meta-data associated with a given digital content with a user identifier stored in the memory. None of the approaches described in Thomson and Audible confirms a user license based upon such a comparison. To the contrary, in Thomson's approach, the renewable security device coupled to the display unit distinguishes between legitimate and illegitimate copies based on embedded Entitlement Control Messages (see page 1, line 33, through page 2, line 10) and, in Audible's approach,

“the playback device checks the digital content for a license that matches the license stored in the playback device” (page 9, lines 5-7).

The Examiner has cited page 1, lines 30-55, of Thomson's disclosure to support her rejection of claim 4. It is noted that there are only 40 lines on page 1. In any event, there is no disclosure on page 1 that provides an explicit or inherent teaching or suggestion of a controller that is configured to confirm a user license based upon a comparison of a user identifier embedded in the meta-data associated with a given digital content with a user identifier stored in the memory of a portable media device.

The Examiner is requested to point to specific language in Thomson's disclosure that she believes expressly or inherently teaches the inventive subject matter recited in claim 4. Otherwise, the Examiner should withdraw the rejection.

b. Claim 6

Claim 6 recites that the controller is configured to enable playback of only a sample of the digital content in response to a failed user license confirmation. Neither Thomson nor Audible expressly or impliedly teaches such a feature.

The Examiner has cited page 2, line 3, through page 4, line 35, of Thomson's disclosure to support her rejection of claim 6. Nowhere in this disclosure, however, is there an explicit or inherent teaching or suggestion of a controller that is configured to enable playback of only a sample of the digital content in response to a failed user license confirmation.

The Examiner is requested to point to specific language in Thomson's disclosure that she believes expressly or inherently teaches the inventive subject matter recited in claim 6. Otherwise, the Examiner should withdraw the rejection.

c. Claim 7

Claim 7 recites that the controller is configured to direct received digital content selectively to unrestricted memory storage or to restricted memory storage based upon a user license confirmation. Neither Thomson nor Audible expressly or impliedly teaches such a feature. Indeed, Thomson does not teach or suggest anything about distinguishing between

unrestricted memory storage and restricted memory storage and, in Audible's mobile hardware playback devices, all digital content is stored in the same memory storage device, such as flash memory, (see page 7, lines 10-19), regardless of whether a user license is confirmed or not.

The Examiner has cited page 2, line 3, through page 4, line 35, of Thomson's disclosure to support her rejection of claim 7. Nowhere in this disclosure, however, is there an explicit or inherent teaching or suggestion of a controller that is configured to direct received digital content selectively to unrestricted memory storage or to restricted memory storage based upon a user license confirmation.

The Examiner is requested to point to specific language in Thomson's disclosure that she believes expressly or inherently teaches the inventive subject matter recited in claim 7. Otherwise, the Examiner should withdraw the rejection.

d. Claim 8

Claim 8 incorporates the features of claim 7 and therefore is patentable for at least the same reasons. Claim 8 also recites that the controller is configured to direct licensed digital content to unrestricted memory storage and to direct unlicensed digital content to restricted memory storage. Neither Thomson nor Audible expressly or impliedly teaches such a feature. Indeed, the devices described in Thomson and Audible store both licensed digital content and unlicensed digital content in the same way.

The Examiner has cited page 2, line 3, through page 4, line 35, of Thomson's disclosure to support her rejection of claim 8. Nowhere in this disclosure, however, is there an explicit or inherent teaching or suggestion of a controller that is configured to direct licensed digital content to unrestricted memory storage and to direct unlicensed digital content to restricted memory storage.

The Examiner is requested to point to specific language in Thomson's disclosure that she believes expressly or inherently teaches the inventive subject matter recited in claim 8. Otherwise, the Examiner should withdraw the rejection.

e. Claim 9

Claim 9 incorporates the features of claim 7 and therefore is patentable for at least the same reasons. Claim 9 also recites that the controller is configured to restrict storage of unlicensed digital works to a predetermined quantity. Neither Thomson nor Audible expressly or impliedly teaches such a feature. Indeed, neither Thomson nor Audible provides any hint about restricting the quantity of digital works (whether licensed or unlicensed) that can be stored in a repository.

The Examiner has cited page 2, line 3, through page 4, line 35, of Thomson's disclosure to support her rejection of claim 9. Nowhere in this disclosure, however, is there an explicit or inherent teaching or suggestion of a controller that is configured to restrict storage of unlicensed digital works to a predetermined quantity.

The Examiner is requested to point to specific language in Thomson's disclosure that she believes expressly or inherently teaches the inventive subject matter recited in claim 9. Otherwise, the Examiner should withdraw the rejection.

f. Claim 10

Claim 10 incorporates the features of claim 7 and therefore is patentable for at least the same reasons explained above.

g. Claim 21

Claim 21 recites that the controller is configured to control wireless transmission and rendering of a particular digital content based upon a comparison of a user identifier embedded in meta-data associated with the particular digital content with a user identifier stored in the memory.

As explained above, the systems described in Thomson and Audible do not confirm a user license based upon such a comparison. To the contrary, in Thomson's approach, the renewable security device coupled to the display unit distinguishes between legitimate and illegitimate copies based on embedded Entitlement Control Messages (see page 1, line 33, through page 2, line 10). In Audible's approach, "the playback device checks the digital

content for a license that matches the license stored in the playback device” (page 9, lines 5-7).

The Examiner has cited page 3, line 30, through page 4, line 20, of Thomson's disclosure to support her rejection of claim 21. The totality of the cited disclosure is quoted in the table contained in section II.A.1.a, above. Nowhere in this disclosure is there an explicit or inherent teaching or suggestion of a controller that is configured to control wireless transmission and rendering of a particular digital content based upon a comparison of a user identifier embedded in meta-data associated with the particular digital content with a user identifier stored in the memory of a portable media device.

The Examiner is requested to point to specific language in Thomson's disclosure that she believes expressly or inherently teaches the inventive subject matter recited in claim 21. Otherwise, the Examiner should withdraw the rejection.

h. Claims 22-24

Claims 22-24 incorporate that features of claim 21 and therefore are patentable for at least the same reasons.

i. Conclusion

For at least these additional reasons, the Examiner's rejection of dependent claims 4, 6-10, and 21-24 under 35 U.S.C. § 103(a) over Thomson in view of Audible should be withdrawn.

B. Claims 12-20

Claim 12 is an independent claim and claims 13-20 depend from claim 12.

Independent claim 12 has been amended and now recites that each of the portable media devices includes features of the portable media device recited in independent claim 1, including a controller that is configured to authorize wireless transmission of a transfer file to a third party device without regard to any identifier of the third party device.

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Claim 12, therefore, is patentable for at least the same reasons explained above in connection with independent claim 1, and the Examiner's rejection of independent claim 12 under 35 U.S.C. § 103(a) over Thomson in view of Audible now should be withdrawn.

Each of claims 13-20 incorporates the features of independent claim 12 and therefore is patentable for at least the same reasons.


III. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

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